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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,486	11/13/2003	David A. Schechter	2876	8330
50855	7590	02/20/2008	EXAMINER	
COVIDIEN			PEFFLEY, MICHAEL F	
60 MIDDLETOWN AVENUE			ART UNIT	PAPER NUMBER
NORTH HAVEN, CT 06473			3739	

MAIL DATE	DELIVERY MODE
02/20/2008	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/712,486
Filing Date: November 13, 2003
Appellant(s): SCHECHTER ET AL.

Edward C. Meagher
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 7, 2008 appealing from the Office action mailed May 7, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed. Applicant has noted that an Amendment After Final was filed on July 16, 2007. An Advisory Action in response to the July 16, 2007 communication was mailed on January 9, 2008, which was after the mailing date of the instant Appeal Brief. It is noted, however, that the July 16, 2007 communication did not include any amendments to the claims. Rather, the July 16, 2007 communication merely made a request for reconsideration of the Final Rejection, which request was entered into the record as indicated on the January 9, 2008 Advisory Action.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,932,816	PHAN	8-2005
6,086,586	HOOVEN	7-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 7-8, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phan (U.S. Pat No. 6,932,816 B2) in view of Hooven (U.S. Pat. No. 6,086,586).

Regarding claim 1, Phan discloses a tissue or vessel sealing instrument, comprising:

a housing 242 having a shaft (internal and not shown) attached thereto (col. 2, ln. 46-65 and Fig. 34); and

an end effector 22, 24 assembly attached to a distal end of the shaft, the end effector assembly including first 22 and second 24 jaw members attached thereto made from a substantially rigid material (col. 5, ln. 61 - col. 6, ln. 2, col. 17, ln. 16-17, and Fig. 5), the jaw members being movable relative to one another from a first position for approximating tissue to at least one additional position for grasping tissue therebetween (Figs. 4-5);

each of the jaw members including an elastomeric material 106 disposed on an inner facing tissue contacting surface thereof (col. 6, ln. 32-35 and Figs. 4-8), each of the elastomeric materials including an electrode 108 disposed therein, the elastomeric material being adapted to compress or deflect about 0.001 inches to about 0.015 inches when the force used to close the jaw members is between about 40 psi to about 230 psi; and

wherein the substantially rigid material of the jaw members resists deformation when the force used to close the jaw members is between about 40 psi to about 230 psi.

Since the elastomeric and rigid materials of Phan are identical to applicant's disclosed materials, they are deemed to inherently, or at least obviously, possess the same material properties at the claimed compression force range.

The claim differs from Phan in calling for the electrodes to be offset a distance X relative to one another such that when the jaw members are closed about the tissue and when the electrodes are activated, electrosurgical energy flows through the tissue in a generally coplanar manner relative to the tissue contacting surfaces. Hooven, however, discloses jaw members with electrodes 42, 44, 46, 48 arranged as claimed so that the flow of current between the electrodes naturally stops when coagulation is complete to prevent thermal damage due to over-coagulation outside the jaws (col. 1, ln. 29 - col. 2, ln. 8, col. 4, ln. 30-45, and Figs. 5-6 and 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

have arranged electrodes on the device of Phan as claimed in view of the teaching of Hooven so that the flow of current between the electrodes naturally stops when coagulation is complete to prevent thermal damage due to over-coagulation outside the jaws.

(10) Response to Argument

Applicant asserts on pages 11 and 12 of the Brief that the examiner's assertion that Phan provides an elastomeric base member on a tissue contacting surface is incorrect. Specifically, applicant asserts that the electrode (108) of Phan contacts tissue and the base member (106) does not contact tissue and cannot be interpreted as being disposed on a tissue contacting surface. The examiner disagrees with this characterization of Phan.

Figure 8 clearly shows that the electrode member (108) takes up only a portion of the surface (106). The examiner maintains that when tissue is grasped, particularly at the closure pressure asserted by applicant, that tissue will inherently be squeezed and conform to the portion of the elastomeric base (106) immediately surrounding the electrode (108). The only way tissue could not be contacted by base member (106) is if the tissue were perfectly flat, hard enough to resist compression, and the closure force were insufficient to cause any deformation of the electrode member (108). Phan clearly discloses the treatment of soft tissue, which tissue would necessarily compress and contact the base member (106) at least in immediate proximity to the electrode member.

Next, the examiner asserts on page 14 of the Brief that the Phan base member does not encompass the electrode. The examiner disagrees. The Phan electrode (108), as shown in Figure 8, is surrounded to the same extent that applicant's electrode is surrounded as shown in the provided figures. In both Phan and the applicant's Figures, the electrode is surrounded by the base member with the exception of a small portion that may contact tissue. Regarding the definition cited, the examiner maintains that the Phan base member (108) clearly surrounds the electrode, at least to the same extent that applicant's base member surrounds the electrode as shown in the Figures. Applicant continues on page 15 of the Brief and states that the Phan base member "does not form a large surface area surrounding the electrode". There is no such limitation in the claims, only that the base member encompasses the electrode. The examiner maintains that Figure 8 of Phan clearly shows this structure.

Applicant has in no way argued the combination of the Hooven teaching with the Phan reference. Rather, applicant has merely argued that the Hooven reference fails to cure the deficiencies of the Phan reference. The examiner maintains that the Phan reference fully discloses the features addressed above, and that the combination of the Hooven teaching with the Phan reference remains a tenable rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Michael Peffley/

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